

REMARKS/ARGUMENTS

Claims 1-26 are pending in this application.

Claims 1-26 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Gabbard (US 6,205,432) in view of Eggleston (U.S. Patent No. 6,101,531). Reconsideration and allowance of the claims are respectfully requested for the following reasons.

Claims 1, 10, 11, 14, 17, 20, and 22 have been amended in this application to further particularly point out and distinctly claim subject matter regarded as the invention. Support for the amended claims may be found in the specification. No new matter has been added.

Rejection under 35 U.S.C. § 103(a)

Claims 1-26 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Gabbard (U.S. Patent No. 6,205,432) in view of Eggleston (U.S. Patent No. 6,101,531). This rejection is respectfully traversed.

Under MPEP § 706.02(j), in order to establish a prima facie case of obviousness required for a § 103 rejection, three basic criteria must be met: (1) there must be some suggestion or motivation either in the references or knowledge generally available to modify the reference or combine reference teachings (MPEP §2143.01), (2) a reasonable expectation of success (MPEP § 2143.02), and (3) the prior art must teach or suggest all the claim limitations (MPEP § 2143.03). See In re Royka, 490 F. 2d 981, 180 USPQ 580 (CCPA 1974).

Applicant respectfully submits that the proposed combination of Gabbard and Eggleston does not teach or suggest each and every claim limitation in claims 1-26. For example, claim 1 recites “sending all the received packets unaltered to a next Internet leg in the transmission path of the file.” The cited references do not teach or suggest this feature.

The final office action of June 16, 2005 claims that this feature is taught by Gabbard at column 12, lines 7-14. The cited passage describes searching the message for the text “MIME-Version” in a header field. If the message is not in a MIME format, it is checked for attachments included within the text of the message converted into a MIME format. Based on the above passage, the final office action further claims that “one of ordinary skill in the art the time of the invention can interpret the search the MIME id in the header and not changing the format of the message on finding the id to the unaltered retransmission of the Digital file.” Following the

reasoning of the final office action, Gabbard describes that messages that are not in the MIME format are converted, while messages in MIME format are not converted. (Step 908 of figure 9 in Gabbard). Column 12, lines 15-16. Thus, some messages are converted while other messages are not. Therefore, not all messages are left unaltered.

In contrast, claim 1 recites "sending all the received packets unaltered to a next Internet leg in the transmission path of the file". Neither Gabbard nor Eggleston teach or describe this feature.

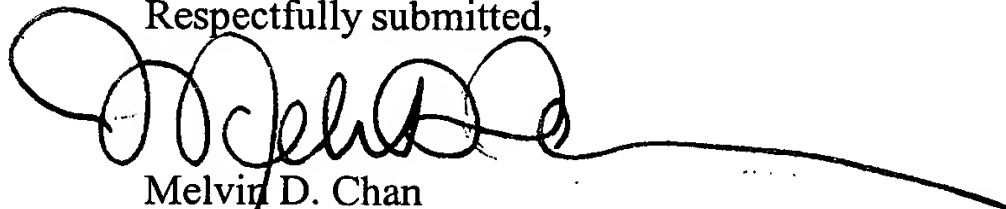
Futhermore, Gabbard describes that regardless of whether the message is converted, background reference is always inserted and thus always altered. See steps 308 and 312 of figure 4 in Gabbard. See column 11, lines 34-37: "Subsequently, as discussed above with respect to background reference insertion process 312, a background reference is inserted into the message." In other words, according to Gabbard, unlike the presently claimed invention, the received message is always altered before it is retransmitted. Therefore, the present invention provides features and benefit not found in the prior art.

Applicant therefore submits that the rejection based on the Gabbard and Eggleston references is improper and should be withdrawn. Thus, applicant submits that claims 1-26 recite novel subject matter which distinguishes over any possible combination of Gabbard and Eggleston.

Conclusion

For the foregoing reasons, applicant believes all the pending claims are in condition for allowance and should be passed to issue. If the examiner feels a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at (408) 701-0035.

Respectfully submitted,



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